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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/578,250

05/04/2006

Hitoshi Aoki

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EXAMINER

MCINTOSH III, TRAVIS C

ART UNIT

PAPER NUMBER

1623

MAIL DATE

DELIVERY MODE

04/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/578,250	Applicant(s) AOKI ET AL.	
	Examiner TRAVISS C. MCINTOSH III	Art Unit 1623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-15 is/are pending in the application.
- 4a) Of the above claim(s) 8-15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The Amendment filed 2/4/2008 has been received, entered into the record, and carefully considered. The following information provided in the amendment affects the instant application by:

Claims 8-15 have been added

Claims 1-6 have been canceled.

Remarks drawn to rejections of Office Action mailed 10/4/2007 include:

Double Patenting Rejection: which has been maintained for reasons of record.

Claim Objections: which have been overcome by applicant's amendments and have been withdrawn.

112 1st paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

112 2nd paragraph rejections: which have been overcome by applicant's amendments and have been withdrawn.

102(b) rejection: which has been overcome by applicant's amendment and has been withdrawn.

An action on the merits of claims 7-15 is contained herein below. The text of those sections of Title 35, US Code which are not included in this action can be found in a prior Office action.

Election/Restrictions

Newly submitted claims 8-15 ARE directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims are drawn to methods of treatment/inhibiting glucose absorption, which is a different statutory class of invention to that previously examined, being compositions and methods of making the same.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 8-15 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Double Patenting

The provisional rejection of claim 7 on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 9-17 of copending Application No. 10/593,465. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application is drawn to a method of making a glucose absorption inhibitor comprising grinding acerola and isolating the extract and the copending application is drawn to the use of acerola extracts for inhibiting glucose elevation in the blood. As such, it would be obvious to one of ordinary skill in the art to make a composition comprising acerola extracts with the '465 application in front of them with such routine steps as "grinding" and "isolating", and also to practice methods of inhibiting glucose absorption with the instant application in front of them. Moreover, it is noted that currently withdrawn claims 8-15 are drawn to very similar methods of use as compared to the '465 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

It is noted that applicants did not argue this rejection and deferred responding.

Claim Rejections - 35 USC § 102

Claim 7 is rejected under 35 U.S.C. 102(b) as being anticipated by Dornoff et al. (US Patent 5,747,006).

Dornoff et al. discloses a method comprising the steps of pitting and reducing a acerola cherry to a puree (grinding) and then separating an extract see column 3, lines 38-50. It is noted that the only steps required by the instant application are grinding acerola fruit; isolating an extract; and purifying the extract, which are seen to have been met by the '006 patent. It is noted that since the Office does not have the facilities for preparing the claimed materials and comparing them with prior art inventions, the burden is on Applicant to show a novel or unobvious difference between the claimed product and the product of the prior art. See *In re Best*, 562 F.2d 1252, 195 USPQ 430 (CCPA 1977) and *In re Fitzgerald et al.*, 619 F.2d 67, 205 USPQ 594 (CCPA 1980). Likewise, applicant's limitation of "producing an inhibitor of glucose absorption" would have been seen to have been inherently performed with the steps as taken in the prior art, absent evidence to the contrary, such as by showing the prior art's composition could NOT be used for the use intended in the instant application.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TRAVISS C. MCINTOSH III whose telephone number is (571)272-0657. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shaojia A. Jiang can be reached on 571-272-0627. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Traviss C. McIntosh III

/Traviss C McIntosh III/
Examiner, Art Unit 1623
April 28, 2008